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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,829	03/22/2004	Jian Bai	10980322-04	4240

22878 7590 06/25/2010  
AGILENT TECHNOLOGIES INC.  
INTELLECTUAL PROPERTY ADMINISTRATION,LEGAL DEPT.  
MS BLDG. E P.O. BOX 7599  
LOVELAND, CO 80537

EXAMINER
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WELLS, NIKITA

ART UNIT	PAPER NUMBER
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2881

NOTIFICATION DATE	DELIVERY MODE
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06/25/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

### Office Action Summary

**Application No.**

10/806,829

**Applicant(s)**

BAI ET AL.

**Examiner**

Nikita Wells

**Art Unit**

2881

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Interference***

1. The Applicants filed a "Request for Continued Examination" (RCE), with a "Declaration of Steven M. Fischer Pursuant to 37 C.F.R. 1.132" on August 25, 2009. The Applicants previously filed a "Response to Notice to Comply with Rule 37 C.F.R. §41.202 (a)(1)-(6)" on November 7, 2005, Pursuant to the provisions of 37 C.F.R. §41.202 (a), where the Applicants suggest that the Office set up an Interference between the present application 10/806,829 and US Patent No. 6,683,300 B2, filed on September 17, 2001. The Applicant canceled claims 1-33 and added claims 34-80 in the "Preliminary Amendment" received March 22, 2004. The Examiner presented newly found prior art as exemplified by the 102(e) and 103(a) rejections of Wang et al. (5,869,832), in view of Franzen et al. (5,663,561), mailed out August 20, 2007. The Applicant responded with a "Amendment and Response" received January 28, 2008, where he pointed out that the above mentioned patents were not applicable to the applicant's invention. The Applicant demonstrated to the Examiner's satisfaction that the newly found art does not disclose the applicant's invention.

2. However, after thorough examination of the newly presented RCE, Response, and Declaration, it was determined that the subject matter as presented in the claims is not described in the specification.

The key element (as shown in the rejection below) of the "reason of allowance" of the invention of Doroshenko et al. (US Patent No. 6,683,300 B2), which is the patent against which the Interference is suggested, is missing from the Specification of the applicant's application, his parent application, or his provisional application. This key element, however, is present in the

Applicant's claims since the claims were copied from the 6,683,300 B2 patent. Therefore, the rejection as shown below, is again presented against the applicant's claims.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 34-80 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to the independent claims 34, 51, and 65, the key element of these claims being: "...irradiating a liquid volume of said analyte solution, without additional matrix added to said analyte solution" has not been found in the Specification of this Application (10/806,829), in the Parent Application (09/146,817)(now US Patent 6,849,847), or the Provisional Application (60/089,088).

Upon review and consideration of the claims, which are found not to be patentable in view of the prior art, it is determined that an interference will not be suggested at this time since examination is not yet completed. See 37 C.F.R. §41.102.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikita Wells whose telephone number is (571) 272-2484. The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by

telephone are unsuccessful, the examiner's supervisor, Robert Kim can be reached on (571) 272-2293. The central fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Nikita Wells/

Primary Examiner, Art Unit 2881

June 18, 2010